

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Steve J. McKinnon

Serial No. 10/034,431

Filed: 12/27/2001

For: **DYNAMIC PRESENCE MANAGEMENT**

Examiner: Hossain, Tanim M.

Art Unit: 2145

Mail Stop Appeal Brief – Patents

Commissioner for Patents

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Sir:

A **REPLY BRIEF** is filed herewith. If any fees are required in association with this Reply Brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REPLY BRIEF

A. Introduction

The questions on appeal are whether the Patent Office has provided a *prima facie* case that claims 1-8, 11-22, 25-34, 37, and 38 are anticipated under 35 U.S.C. § 102(e) by Boyer et al. (hereinafter “Boyer”), and that claims 9, 10, 23, 24, 35, and 36 are obvious under 35 U.S.C. § 103(a) over Boyer in view of McDowell et al. (hereinafter “McDowell”). For the rejections under 35 U.S.C. § 102(e), the Patent Office has not shown where all of the elements of independent claims 1, 15, and 27 are shown with the requisite particularity to sustain an anticipation rejection. For the rejections under 35 U.S.C. § 103(a), in light of Boyer and McDowell, the Patent Office has failed to establish *prima facie* obviousness. In particular, nothing in McDowell cures the deficiencies of Boyer. Neither Boyer nor McDowell, alone or in combination, teach or suggest creating the service logic in the presence detection system and providing the service logic from the presence detection system to the presence service as recited in the claims for the present invention.

B. Argument

1. Boyer Does Not Teach Receiving State Information and Creating Service Logic at the Presence Detection System

Specifically, Boyer fails to teach receiving state information and creating service logic based on this state information **at the presence detection system**. Since these elements are recited in the claims, and Boyer does not disclose these elements, independent claims 1, 15, and 27 are not anticipated. Further, claims 2-8, 11-14, 16-22, 25, 26, 28-34, 37, and 38, which depend on claims 1, 15, and 27, are not anticipated by Boyer.

In the Examiner’s Answer, the Patent Office states that Boyer discloses that the state information is received by the User Agent (which is part of the Softswitch Programmable Feature Server (SPFS); see Boyer, paragraph 0021) and that service logic is generated at the SPFS (see Examiner’s Answer mailed June 16, 2006, pp. 7-8). However, the Patent Office takes the position that, under a broad reasonable interpretation, the User Agent and the SPFS constitute the presence detection system as claimed (Examiner’s Answer mailed June 16, 2006, p. 8). Appellant respectfully disagrees. The SPFS (which includes the User Agent) of Boyer is not the

same as the claimed presence detection system. That is, in Appellant's system, the presence detection system includes a presence detection device such as a keyboard, mouse tracker, video camera, or the like (see paragraphs 0017 and 0018 of the specification as filed) and would not include the SPFS.

While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Regardless of the point of view, reasonable is the operative part of the standard. In light of the way the term "the presence detection system" is used in Appellant's specification (see, e.g., paragraphs 0017 and 0018), a person of ordinary skill in the art would not reasonably interpret the claimed presence detection system to include the SPFS of Boyer. Further, "a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (emphasis added and citations omitted). Applicant respectfully submits that Boyer does not contain all the elements of the claims, arranged as claimed in the present invention. Thus, Boyer cannot anticipate the claimed invention.

2. Boyer Does Not Teach Providing the Service Logic from the Presence Detection System to an Associated Presence Service to Distribute Generation of the Service Logic

Boyer also fails to disclose providing the service logic from the presence detection system to an associated presence service to distribute generation of the service logic. Since the Patent Office maintains that the SPFS is part of the presence detection system, then Boyer does not teach providing the service logic from the presence detection system to the associated presence service as recited in the claims. The Patent Office asserts that the service logic is distributed to the ConnectIcon View, TeamPortal View, etc., which are the applications that provide the interface through which the human client may communicate with the user. Thus, the Patent Office is equating these applications to the claimed associated presence service. Once again, the Patent Office is relying on a broad reasonable interpretation to argue that the

applications constitute the claimed associated presence service since they are associated with user presence and provide a service to the human client.

As set forth above, the broad reasonable interpretation is determined from the point of view of someone skilled in the art and the interpretation must be consistent with the specification. MPEP § 2111. Appellant's specification discloses that the associated presence service is a presence server 18 (Specification, paragraph 0016; Figure 1). The applications disclosed in Boyer (ConnectIcon View, TeamPortal View, etc.) are not equivalent to the claimed associated presence service. In fact, ConnectIcon View, TeamPortal View, and the like, are actually presence clients (Boyer, paragraph 0040). A person of ordinary skill in the art reading Applicant's specification would not reasonably interpret the presence clients of Boyer to be equivalent to the claimed associated presence service. Since Boyer does not teach the associated presence service of the claimed invention, Boyer cannot teach providing the service logic from the presence detection system to the associated presence service to distribute generation of the service logic. Thus, Boyer does not anticipate the present invention for this additional reason.

3. Claims 9, 10, 23, 24, 35, and 36 Are Not Obvious in Light of the Combination of Boyer and McDowell

With respect to dependent claims 9, 10, 23, 24, 35, and 36, Appellant reiterates and relies upon its arguments in the Appeal Brief (see pp. 8-9 of Appeal Brief mailed March 14, 2006). Specifically, Appellant asserts that the motivation asserted by the Patent Office lacks any evidence in support thereof. Merely because a combination is possible or the references are in the same field of endeavor does not make a combination obvious. MPEP § 2143.01. The Patent Office has failed to provide the required evidence, indicating that this combination relies on impermissible hindsight reconstruction. As such, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the claims are non-obvious and allowable. Appellant requests withdrawal of the § 103(a) rejection on this basis.

Even if the combination is proper, a point which Appellant does not concede, the combination does not establish obviousness because the combination does not teach creating the service logic in the presence detection system and providing the service logic from the presence detection system to the associated presence service as recited in the claims. That is, as explained

above, Boyer does not teach or suggest each and every element. Nothing in McDowell cures the deficiencies of Boyer. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the Patent Office has not established obviousness and the claims are allowable. Appellant requests withdrawal of the § 103(a) rejection on this basis as well.

C. Conclusion

Boyer fails to disclose or suggest receiving state information bearing on the presence of a user and creating service logic based on the user at a presence detection system. Boyer further fails to disclose providing the creative service logic from the presence detection system to an associated presence service. McDowell also fails to disclose or suggest these elements. As such, Boyer and McDowell, alone or in combination, fail to disclose or suggest the claimed invention. Appellant respectfully requests that the Board reverse the Examiner and instruct the Examiner to allow the pending claims 1-38.

Respectfully submitted,

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